



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0974-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3689
)
Application No.: 10/024,333) Examiner: Gerardo Araque, Jr.
)
Filed: December 21, 2001) Confirmation No.: 4711
)
For: METHODS AND SYSTEMS FOR)
GENERATING A PROGNOSIS)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the Final Office Action dated April 10, 2009 ("Final Office Action"), rejecting claims 1-48, in the above-referenced patent application. In accordance with M.P.E.P. § 1204.01, the prior payments of the \$500.00 Appeal Brief fee previously filed on June 13, 2007, and the \$10.00 additional Appeal Brief fee previously filed on September 2, 2008, should be applied to this Appeal Brief. Appellants submit herewith a payment of \$30.00, which is the difference between the currently required Appeal Brief fee of \$540.00 under 37 C.F.R. § 1.17(c) and the previously paid fees of \$510.00.

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A Notice of Appeal was filed on June 19, 2009. This Appeal Brief is being filed along with a petition for a one-month extension of time and fee payment. If any additional fees are required, or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. Real Party In Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by the assignment duly recorded in the U.S. Patent and Trademark Office, beginning at Reel 012934, Frame 0114, on May 29, 2002.

II. Related Appeals and Interferences

Appellants, Appellants' legal representative, and Assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status Of Claims

Claims 1-48 are pending in this application. Claims 1-48, as set forth in the Claims Appendix, were rejected in the Final Office Action and the rejections applied to those claims are at issue in this appeal.

IV. Status Of Amendments

No amendments have been filed subsequent or in response to the Final Office Action.

V. Summary Of Claimed Subject Matter

A. Independent claim 1

Independent claim 1 recites a computer-implemented method of enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving, in a memory, at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20.¹ The method also comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method further comprises generating, using a processor, based on both the received representation and the information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method further comprises outputting, to a device, the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

B. Independent claim 31

Independent claim 31 recites a system for enabling determination of prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representation of the subject's external body condition. Fig. 1,

¹ The designations of reference numerals and identifications of portions of the specification and drawings in this Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. These designations and references are exemplary and non-exhaustive, and they should not be construed as limiting the claims.

item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises a database for storing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises a driver for outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

C. Independent claim 32

Independent claim 32 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises means for receiving at least one representation of the subject's external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises means for generating, based on both the representation and information contained in the database, at least

one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises means for outputting the prognosis to enable the subject to receive the prognosis. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

D. Independent claim 47

Independent claim 47 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representative image of the subject's external body condition. Fig. 1; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises a secondary storage storing a mesh frame representative of at least one part of human anatomy. Page 11, lines 4-10. The system further comprises a database containing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C; Fig. 8D; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product. Fig. 2; page 17, line 13 - page 18, line 4. The system further

comprises a driver for outputting the prognosis image to enable the subject to view the prognosis image. Page 19, lines 7-15.

E. Independent claim 48

Independent claim 48 recites a computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The method comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60, Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method comprises generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method comprises outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed:

A. Claims 31-36, 38-45, and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,081,611 to Linford et al. ("Linford").

B. Claims 1-30, 37, 46, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Linford in view of the archived Internet website of Proactiv (http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php) ("Proactiv").

VII. Argument

**A. The Rejection of Claims 31-36, 38-45, and 47 Under
35 U.S.C. § 102(b) Based on Linford Should Be Reversed**

1. Claim 31

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P § 2131; see *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 31 recites, among other things, “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” In the Final Office Action at 3, the Examiner asserts that Linford discloses the recited subject matter in column 5, lines 30-57. Appellants respectfully disagree.

Linford discloses “[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit” and that the memory “generally

comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. Thus, Linford fails to disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In the Final Office Action at 16-17, the Examiner asserts, without citing any authority, that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art.” Appellants submit that, regardless of whether the Examiner assertion has any merit, the Final Office Action fails to address the structural differences between claim 1 and Linford. As explained above, the Linford reference fails to mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. This is because Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure of any modification of the image being based on information stored in a database. This is at least one example of a structural difference between the claimed invention and Linford.

In the Final Office Action at 7, with respect to claims 1 and 48, the Examiner even admits that “Linford . . . fails to disclose: maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.” The Examiner’s own admission confirms that Linford does not disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In addition, because Linford does not disclose a database that stores information on how use of at least one beauty product would affect evolution of an external body condition, Linford fails to disclose “a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31. As explained above, Linford enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. A system for handling manual editing of a preoperative image is not the same as “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31.

In the Final Office Action at 16, the Examiner asserts that “in order for the user to manipulate the image to the desired outcome, the system must require data that instructs the system on how to carry out or perform the manipulation desired by the user.” The Examiner’s assertion, however, appears to overlook the fact that “a

database for storing information on how use of at least one beauty product affects evolution of [an] external body condition” is not inherently described in Linford.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

The Final Office Action fails to provide sufficient evidence from Linford, or any extrinsic evidence, that the subject matter of claim 31 is necessarily present in the reference, or that a database is necessarily present in a system such as the system of Linford. The Final Office Action also fails to present sufficient factual basis and technical reasoning to demonstrate inherency. For example, a system having instructions on how to carry out or perform the manipulation desired by a user does not necessarily include a database. The instructions are not necessarily stored in a database, and may be stored in a file system. In addition, the instructions do not necessarily require a database, and may be performed without a database in the system. For example, a drawing software that carries out user’s desired edit inputs can run on a personal computer without the need of a database in the computer.

Consequently, the Examiner cannot properly infer that a database is inherently included in a system having instructions on how to carry out or perform the manipulation desired by a user, such as in the system of Linford. Moreover, even assuming that a database is inherently included in the system of Linford, Linford fails to teach or suggest the existence of any “information on how use of at least one beauty product affects evolution of [an] external body condition” in its system, as recited in independent claim 31.

In the Final Office Action at 16, the Examiner also asserts, without citing any authority, that “the data stored in the system of claims 31, 32, and 47 are nonfunctional descriptive subject matter since the type of data adds little, if anything, to the claim’s structure, and, thus, does not serve as limitation on the claims to distinguish over the prior art.”

Appellants fail to see how the “functional and nonfunctional descriptive subject matter” test typically reserved for determining statutory subject matter under 35 U.S.C. § 101 is relevant in determining patentability under 35 U.S.C. § 102. M.P.E.P. § 2143.03, instead, clearly provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In addition, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d at 587, 172 USPQ at 526. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson*, 868 F.2d at 1236, 9 USPQ2d at 1920. The Examiner’s position, which completely ignores certain words in a claim in judging patentability under § 102 is neither supported by the M.P.E.P. nor by case law.

For at least the above reasons, Linford does not support the § 102(b) rejection of independent claim 31. Therefore, the § 102(b) rejection of independent claim 31 based on Linford should be reversed.

2. *Claim 32*

Independent claim 32, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 32 recites, among other things, “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32.

For at least the above reasons, the § 102(b) rejection of independent claim 32 based on Linford should be reversed.

3. *Claim 47*

Independent claim 47, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 47 recites, among other things, “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that] modif[ies a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product,” as recited in independent claim 47.

Independent claim 47 recites further distinctions from Linford. For example, independent claim 47 recites “a secondary storage storing a mesh frame representative of at least one part of human anatomy.” In the Final Office Action at 6, the Examiner asserts that Linford discloses the recited subject matter in column 5, lines 30-57. Appellants respectfully disagree.

As explained above with respect to independent claim 31, Linford discloses “[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit” and that the memory “generally comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention “a mesh frame representative” or disclose any component for storing “a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47. Thus, Linford fails to disclose “a secondary storage storing a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47.

In the Final Office Action at 17, the Examiner asserts that Linford “discloses utilizing 3D imaging in order to better represent the prognosis.” Despite the assertion, nowhere does Linford disclose utilizing 3D imaging in order to better represent the prognosis.” See, FIGS. 6, 7A-E, 8A-E, 9D-G, 11, 14A-D, 15A-C, 16, 17, 18A-C, 19A-B, and 20. In addition, Linford, at col. 18, lines 41-52, merely describes a rotating tool, which enables a user to select a rotating axis for rotating a section of a 2-D image.

Even assuming *arguendo*, that Linford discloses “utilizing 3D imaging in order to better represent the prognosis,” as asserted by the Examiner, the assertion appears to overlook the fact that “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is not inherently described in Linford. The Final Office Action fails to provide sufficient evidence from Linford, or any extrinsic evidence, that the subject matter of claim 47 is necessarily present in the reference, or that “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is necessarily present in the system of Linford. The Final Office Action also fails to present a sufficient factual basis and technical reasoning to demonstrate inherency. For example, a system may utilize 3D imaging in order to better represent the prognosis, without any “secondary storage storing a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47. The mere fact that a system utilizes 3D imaging in order to better represent the prognosis does not necessarily make a secondary storage present in the system. Consequently, “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is not inherently included in the system of Linford.

In the Final Office Action at 16, the Examiner also asserts, without citing any authority, that “the type of data adds little, if anything, to the claim’s structure, and thus does not serve as a limitation on the claims to distinguish over the prior art.” As explained above with respect to independent claim 31, M.P.E.P. § 2143.03 clearly provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” The Examiner’s position, which completely ignores

certain words in a claim in judging patentability under § 102 is neither supported by the M.P.E.P. nor by the case law.

For at least the above reasons, the § 102(b) rejection of independent claim 47 based on Linford should be reversed.

4. *Claims 33-36 and 38-45*

Claims 33-36 and 38-45 depend from independent claim 32. Thus, claims 33-36 and 38-45 incorporate the elements that are missing from Linford, as discussed above. Accordingly, the rejection of dependent claims 33-36 and 38-45 under 35 U.S.C. § 102(b) should be reversed.

**B. The Rejection of Claims 1-30, 37, 46, and 48 Under
35 U.S.C. § 103(a) Based on Linford in view of Proactiv Should
Be Reversed**

The rejection of claims 1-30, 37, 46, and 48 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences

between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

1. *Claim 1*

Independent claim 1 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “generating, . . . based on both [a] received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.”

As explained above, Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure or suggestion of any modification of the image being based on information stored in a database. In the Final Office Action at 7, the Examiner thus correctly observes that Linford fails to disclose “maintaining, in a

database, information of how use of at least one beauty product affects evolution of the external body condition.” In addition, because Linford does not teach “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” Linford does not also teach or suggest “generating, based on both the received representation and information contained in the database, at least on prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 1 (emphasis added).

Proactiv fails to cure the deficiencies of Linford. In the Final Office Action at 7, the Examiner asserts that “Proactiv [purportedly] discloses how the use of a beauty product affects the evolution of an external body condition, wherein the information is stored in a database.” (Emphasis omitted.) Appellants respectfully disagree and submit that Proactiv shows web pages containing text and graphics describing beauty products. The pages, by themselves, do not teach or suggest that “the information is stored in a database,” as asserted by the Examiner.

Further, even assuming, *arguendo*, that Proactiv teaches that “the information is stored in a database,” as asserted by the Examiner, nothing in Linford or Proactiv teaches or suggests that the information in a database is used, in any way, to generate at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty product. The information in text (e.g., sentences in paragraphs), as shown in web pages of Proactiv, is not structured in any way that would appear to be used in generating at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty products.

In the Final Office Action at 18, the Examiner asserts that “Linford does disclose that information stored in a database is used to create the post-operative image,” without citing any basis for the Examiner’s assertion. (Emphasis omitted.) Appellants respectfully disagree and submit that the Examiner mischaracterizes Linford because the Linford reference does not even mention a “database” or disclose any maintaining of information on how use of at least one beauty product affects evolution of an external body condition.

In the Final Office Action at 18, the Examiner further asserts that claim 1 recites “a combination which only unite old elements with no change in their respective functions and which yield predictable results.” “Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither the appellant’s specification nor the appellant’s arguments present any evidence that modifying Linford with the selected elements of Proactiv was uniquely challenging or difficult for one of ordinary skill in the art.” Final Office Action at 18. Appellants cannot disagree more.

The Examiner is essentially, in a clearly improper hindsight fashion, arguing that an image editing tool based on a user input and a website can somehow be combined to “generat[e], using a processor, based on both [a] received representation and . . . information” contained in the website, “at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product,” as recited in independent claim 1. Appellants submit that the function of a website is presenting a web page, and the function of an image editing tool based on a user input is editing an image in response to an input from a user. Without changing their respective functions, the web page, maintained in the website of Proactiv, cannot

function as a user input, in the image editing tool of Linford, to “generat[e] . . . at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product,” as recited in independent claim 1.

Moreover, the Supreme Court in *KSR* emphasized that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Federal Circuit has also stated that, even after the Supreme Court’s decision in *KSR*, “a flexible [teaching, suggestion, and motivation] test remains the primary guarantor against a non-statutory hindsight analysis.” *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008). *KSR* does not lift the Examiner’s burden of establishing a *prima facie* case of obviousness, and the Examiner’s reliance on *KSR*, especially in combination with the Examiner’s improper hindsight reasoning, is clearly erroneous.

Furthermore, neither the M.P.E.P. nor the case law requires Appellants to present any evidence that modifying Linford with the selected elements of Proactiv was uniquely challenging or difficult for one of ordinary skill in the art. Because the Examiner has not properly established a case for *prima facie* obviousness, Appellants are under no obligation to present such evidence. Negative inference cannot be taken from the absence of such evidence, and the absence of such evidence cannot be used in any way to establish a *prima facie* case of obviousness.

In view of the above-noted deficiencies and mischaracterizations of the Linford and Proactiv references, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the

prior art and the invention of independent claim 1. Therefore, the Final Office Action has failed to clearly articulate a reason why claim 1 would have been purportedly obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claim 1, and the rejection under 35 U.S.C. § 103(a) should be reversed.

2. *Claim 48*

Independent claim 48, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 1. For example, independent claim 48 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition,” and “generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” As explained above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with respect to independent claim 1. For at least reasons similar to the reasons set forth above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with respect to independent claim 48, and therefore, Linford and Proactiv, taken alone or in combination, fail to support the rejection under 35 U.S.C. § 103(a). Accordingly, the rejection under 35 U.S.C. § 103(a) should be reversed.

3. *Claims 2-30*

Claims 2-30 depend from independent claim 1. Claims 2-30 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, the rejection of dependent claims 2-30 under 35 U.S.C. § 103(a) should be reversed.

In addition, the dependent claims recite further distinctions over the cited references.

i. *Claims 17-19*

Dependent claim 17 recites, among other things, a “beauty product [that] is chosen from skin products, hair products, and nail products.” Dependent claim 18 recites, among other things, a “beauty product [that] comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.” Dependent claim 19 recites, among other things, a “hair product chosen from a conditioner and a shampoo.” In the Final Office Action at 11, the Examiner admits that the “combination of Linford and Proactiv fails [to] disclos[e] wherein the beauty product is chosen from skin products, hair products, and nail products, moisturizers, wrinkle removers, and hair product chosen from a conditioner and a shampoo.” (Emphasis omitted.) The Examiner, however, alleges, in a clearly improper hindsight fashion that “it would have been obvious to one having ordinary skill in the art that a variety of beauty products can be used and all would produce the same predictable result of generating a prognosis showing the effects of using a beauty product.” The hindsight reasons identified by the Examiner are, at best, conjectural and not supported by any findings.

For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be reversed.

ii. Claim 25

Dependent claim 25 recites, among other things, “rendering [a] prognosis on a three-dimensional mesh image.” Linford discloses that “another view option provided to the user in the aesthetic imaging system is an Emboss option.” Linford, col. 25, lines 19-20. “The emboss option displays an image that is *similar* to an etching made of a three-dimensional raised surface.” Linford, col. 25, lines 25-27 (emphasis added). Thus, although “similar,” the emboss option still portrays an image as a two dimensional image, “with the depth of the raised surface indicated by a darker shade of gray.” As shown in FIGS. 6, 7A-E, 8A-E, 9D-G, 11, 14A-D, 15A-C, 16, 17, 18A-C, 19, and 20 of Linford, none of the images is a three-dimensional mesh image. For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be reversed.

4. Claims 37 and 46

Claims 37 and 46 depend from independent claim 32. As discussed above with respect to independent claim 32, Linford fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32. Proactiv also does not disclose or suggest these features recited in claim 32. As explained above with respect to independent claim 1, Proactiv fails to teach or suggest “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “generating, . . . based on both the received representation and information contained

in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product," as recited in independent claim 1. Thus, Proactiv also fails to teach or suggest "means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition," and "means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product," as recited in independent claim 32, and thus fails to cure the deficiencies of Linford. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 37 and 46, and the rejection under 35 U.S.C. § 103(a) should be reversed.

VIII. Conclusion


For the reasons given above, claims 1-48 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. §§ 102(b) and 103(a), so that those pending claims may be allowed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 1, 2009

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IX. Claims Appendix

1. A computer-implemented method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:
receiving, in a memory, at least one representation of the subject's external body condition;
maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;
generating, using a processor, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product;
and
outputting, to a device, the prognosis to enable the subject to receive the prognosis.
2. The method of claim 1, wherein the at least one representation defines the external body condition.
3. The method of claim 1, wherein the at least one representation comprises at least one representative image of the external body condition.
4. The method of claim 1, wherein the prognosis comprises a prognosis image.

5. The method of claim 4, wherein the prognosis image comprises a three-dimension prognosis image.

6. The method of claim 1, further comprising transmitting to the subject instructions relating to obtaining of the representation.

7. The method of claim 6, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

8. The method of claim 1, further comprising constructing, using a processor, an image based on the representation, wherein said generating of the prognosis comprises comparing the constructed image to the information in the database.

9. The method of claim 3, wherein the information in the database comprises image morphing information, and wherein said generating of the prognosis comprises morphing the representative image based on the image morphing information.

10. The method of claim 1, wherein the representation is received via a network, and wherein the subject is located at a location remote from a location where the database is maintained.

11. The method of claim 1, wherein the representation is stored in a data storage device.

12. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

13. The method of claim 12, wherein the outputting further comprises outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

14. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

15. The method of claim 14, wherein the outputting further comprises outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis.

16. The method of claim 14, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, frequency of use of the product, the length of time between each use of

the product, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

17. The method of claim 1, wherein the beauty product is chosen from skin products, hair products, and nail products.

18. The method of claim 1, wherein the beauty product comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.

19. The method of claim 1, wherein the beauty product comprises a hair product chosen from a conditioner and a shampoo.

20. The method of claim 1, further comprising outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.

21. The method of claim 1, wherein the generating the prognosis comprises comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.

22. The method of claim 1, wherein the outputting the prognosis comprises transmitting the prognosis to a device via a network.

23. The method of claim 1, wherein the at least one beauty product is selected from a plurality of differing beauty products, and wherein the method further comprises receiving a selection of the at least one beauty product.

24. The method of claim 23, further comprising enabling the subject to make the selection of the at least one beauty product from the plurality of beauty products.

25. The method of claim 1, further comprising rendering the prognosis on a three-dimensional mesh image.

26. The method of claim 25, further comprising generating a mathematical model corresponding to a three-dimensional image resulting from the rendering of the prognosis on the three-dimensional mesh image.

27. The method of claim 3, further comprising enabling modification of the representative image based on an input by the subject.

28. The method of claim 27, wherein the input by the subject further comprises at least one of the addition and removal of wrinkles from the representative image.

29. The method of claim 28, wherein said at least one of the addition and removal of wrinkles comprises modifying at least one parameter associated with a mathematical model corresponding to the image.

30. The method of claim 26, wherein generating at least one prognosis comprises modifying at least one parameter associated with the mathematical model.

31. A system for enabling determination of prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representation of the subject's external body condition;

a database for storing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and

a driver for outputting the prognosis to enable the subject to receive the prognosis.

32. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

means for receiving at least one representation of the subject's external body condition;

means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and

means for outputting the prognosis to enable the subject to receive the prognosis.

33. The system of claim 32, further comprising means for enabling the subject to receive instructions relating to obtaining of the representation.

34. The system of claim 33, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

35. The system of claim 32, further comprising means for constructing a representative image, wherein said means for generating the prognosis compares the constructed image to the information in the database.

36. The system of claim 32, wherein the representation comprises at least one representative image of the external body condition, wherein the information in the database comprises image morphing information, wherein said means for generating

the prognosis comprises means for morphing the representative image based on the image morphing information.

37. The system of claim 32, wherein the means for receiving comprises means for receiving the representation image data via a network.

38. The system of claim 32, wherein the representation is stored in a data storage device, and wherein said means for receiving the representation comprises means for receiving the data storage device.

39. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

40. The system of claim 39, wherein the means for outputting further comprises means for outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

41. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

42. The system of claim 41, wherein the means for outputting further comprises means for outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis image.

43. The system of claim 41, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, the frequency of use of the product, the length of time between each use of the project, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

44. The system of claim 32, further comprising means for outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.

45. The system of claim 32, wherein the means for generating the prognosis comprises means for comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.

46. The system of claim 32, wherein the means for outputting the prognosis comprises means for transmitting the prognosis via a network.

47. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representative image of the subject's external body condition;

a secondary storage storing a mesh frame representative of at least one part of human anatomy;

a database containing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product; and

a driver for outputting the prognosis image to enable the subject to view the prognosis image.

48. A computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:

receiving at least one representation of the subject's external body condition;

maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and
outputting the prognosis to enable the subject to receive the prognosis.

X. Evidence Appendix

None

XI. Related Proceedings Appendix

None